

REMARKS

The foregoing amendment provides a new title for the application, a paragraph cross-referencing Applicant's parent application and a revised Abstract. In addition, the specification is being amended in various places to obviate certain objections raised by the Examiner.

None of the amendments introduce new matter. For example, the amendment to the fourth paragraph on page 6 is supported in original claims 2-4.

Claims 5, 6 and 7 have been amended to obviate certain rejections under 35 U.S.C. § 112. Support for claims 9 and 10 is found in original claims 2-4. Support for claims 11 and 12 is found on page 8, lines 5-10, and lines 18-21 of the specification.

Objection to Claim 5

The Examiner objects to claim 5 because of the informality that the actual pigment formulation should be recited, rather than simply referring to claim 1. Applicant has amended claim 5 to recite the pigment formulation and removed the reference to claim 1.

Rejection Under 35 U.S.C. § 112, Second Paragraph

The Examiner has rejected claims 5-7 under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicant respectfully traverses the Examiner's rejection.

The Examiner contends that claim 5 is indefinite as "primary and secondary viewpoints" lack proper antecedent basis, "dense" is a relative term, and that the phrase "automotive paint or ink" fails to clearly define the intended paint or ink. Applicant has amended claim 5 to more precisely define the subject matter of the invention. Support for the amendments describing the "primary viewpoint" is found on: page 4, lines 11-14 and lines 23-24; page 5, line 28 and page 9, line 20 and lines 35-36. Support for the

amendments describing the “secondary viewpoint” is found on page 9, lines 32-34 of the specification. Further support for the amendments to claim 5 can be found on page 6 paragraphs 1 – 3. Applicant therefore, respectfully requests that the Examiner’s rejection be withdrawn.

The Examiner contends that claims 6-7 are vague and indefinite because they are method claims which refer to formulation claim 3. Applicant has amended claim 6 and 7 to more precisely define the subject matter of the invention by changing the dependency to independent claim 5.

Rejection of Claims 5-6 under 35 U.S.C. §103(a)

The Examiner states that claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neer U.S. Patent No. 5,680,893 (“Neer”), in view of Thomas U.S. Patent No. 5,518,803 (“Thomas”). Applicant submits that neither Neer nor Thomas, alone or in combination, teach the subject matter of Applicant’s invention which rests within the combination of the appropriate pigment formulation impregnated into the net material in such a manner that an image formed thereby will be sufficiently durable so as to withstand, for example, the impact of hockey pucks and extreme outdoor weather conditions, yet not bleed through the fiber so as to be visible on the reverse side. Applicant respectfully traverses the Examiner’s rejection and submits that the Examiner has failed to meet the burden of establishing a *prima facie* case of obviousness in view of the cited prior art references.

It is the Examiner’s position that it would have been obvious to one of ordinary skill in the art to modify the method of Neer by incorporating the conventional patterning means of Thomas. Neer teaches that fencing or screen product may be “coated” with decorative patterns to provide durable decorative coatings which withstand weathering, chipping, peeling and fading. Moreover, it is stated that one would have recognized the

obviousness of modifying the viscosity of the pigment formulations used in Neer by addition of diluents to "adjust [the coating material] to sufficient viscosity for suitable flow" so that a worker could "spread" the coating material "on the substrate surface" by mechanical means, spraying, printing or curtain coating.

Applicant contends that it would not have been obvious to a worker skilled in the art to make a pigment formulation that contains automotive paint for use on metal surfaces or ink and diluent, in the claimed ratio, which is saturated with water, and to use such a formulation to impregnate a multi-filamentous net or mesh with images and yet not damage the net fiber. Such an accomplishment is not obvious in light of Neer and Thomas, nor is it a mere result of "routine experimentation."

Applicant contends that it would not have been obvious to modify the viscosity of the pigment formulations used in Neer in order to obtain a formulation that could impregnate and absorb into a multi-filamentous net or mesh, as detailed in the instant invention, such that an image formed thereby will be deep enough within the material and of the right chemical composition so as to be sufficiently durable to withstand the impact of hockey pucks, for example. Applicant asserts that, in order to be able to withstand "extreme conditions" which are defined on page 5, lines 7 – 8 of Applicant's specification to include "harsh weathering and high force impacts from hockey pucks, baseballs, sports equipment and various projectiles," one cannot use just any pigment formulation, such as those described in lines 57 – 63, column 6 and lines 25 – 57 of column 7, of Neer, which are designed to meet different criteria.

Requirements for Applicant's pigment formulation are described, for example, on page 6 of the instant specification in paragraphs 1 – 3, and particularly the necessity for the ratio of paint-to-diluent at lines 27 – 28 on page 6. The specification further teaches that "the composition must set in a short period of time (approximately 5 minutes) so that it will not bleed through the fibers or around the circumference of the netting material,

extending the image to the opposite side of the net. It must not be so thick that it peels or flakes, especially upon impact. It must dry slowly enough so that it has time to soak into the fiber, enabling it to withstand a large number of impacts without flaking or chipping away (page 6, lines 28 – 33). Moreover, on page 3, line 35 Applicant states that the paint formulation must not compromise the integrity of the fibers nor cause the colours to diffuse uncontrollably.” Thus, Applicant teaches a method for impregnating pigment formulations comprising paint or ink into nets, sports nets in particular, such that they are able to withstand the rigors of outdoor sports, whereas Neer teaches coating only decorative pigment polymer-based coatings onto privacy screens.

In addition to the pigment formulation and its relationship to the material (*i.e.*, impregnated vs. coated), the objective and result of Applicant’s method is different from that of Neer, who teaches coating “decorative pigment coatings” onto privacy screens “such that the light reflective and absorptive properties of the decorative pattern viewed from said first side decrease the ability of a viewer to view activities of persons on the opposite side of the screen,” and wherein “[t]he ultimate product is such that the colors of the decoration cooperate such that one side is a reflective pattern while preventing transmitting images through the decorated product to allow privacy” The screen of Neer is used for privacy purposes and decreases the ability of a viewer to view activities or persons on the opposite side of the screen, which is precisely the opposite desired effect of the instant invention.

Applicant’s method teaches that “it is necessary to have the image restricted to one side of the net or mesh to comply with sporting regulations that prohibit interfering with a judging official’s clear view of a net . . . would also minimize the image from being seen from the side when the net is moving.” (page 3, lines 23 – 27). Please see also page 9, lines 29 – 33; page 10, lines 33 – 34. Thus, Applicant believes that, in light of Neer and taking into consideration the knowledge of a worker skilled in the art, it would not have

been obvious to design a net or mesh with an image on one side that allows a viewer a totally unobstructed view of activities or persons on the opposite side of the net or mesh from one perspective while being able to view a clear image from an alternative perspective.

The Examiner states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Neer by incorporating the conventional patterning means of Thomas because there would have been the expectation of successfully applying the polymer-based paints to a woven or mesh fencing or screen product. The fact that the pigment formulations of the instant invention impregnate and absorb into the net or mesh material and not merely just “spreading the coating material on the substrate surface”, the method is inventive and is not obvious in light of Neer and Thomas. Thomas simply teaches methods of applying decorative patterns using standard techniques such as spraying ink or paint through a printing screen stencil, and refers to standard means such “a free-hand approach.”

Applicant asserts that the Examiner has not shown a *prima facie* case of obviousness that the paint of Neer applied to a net or mesh using the designs of Thomas will not detrimentally affect the substrate mesh and the resulting product’s practical utility. Applicant, therefore, respectfully requests that the Examiner withdraw this objection.

Rejection of Claim 7 Under 35 U.S.C. §103(a)

The Examiner has rejected claim 7 under 35 U.S.C. §103(a) as being unpatentable over Neer in view of Thomas, and further in view of Levy *et al.* U.S. Patent No. 4,559,732 (“Levy”). Levy adds the concept of projecting the images onto the subject matter to form accurate or enlarged outlines of the desired decorative pattern. Applicant respectfully traverses this rejection.

Applicant : Bourdages
Serial No. : 09/904,044
Filed " : July 12, 2001
Page : 18 of 18

Attorney's Docket No.: 11005-002002 / 20577/US

For the reasons stated above, neither Neer nor Thomas, alone or in combination, teach the subject matter of Applicant's invention which rests within the combination of the appropriate pigment formulation impregnated into the net material in such a manner that an image formed thereby will be deep enough within the material to be sufficiently durable so as to withstand the impact of hockey pucks and extreme outdoor weather conditions, yet not bleed through the fiber so as to be visible on the reverse side. The addition of Levy does not render Applicant's invention obvious. Thus, the Examiner has also failed to provide a *prima facie* case of obviousness. Applicant, therefore, respectfully submits that the 35 U.S.C. §103(a) rejection is unsupported by the art, and withdrawal of this rejection is respectfully requested.

CONCLUSION

In view of the foregoing remarks and the instant amendment, it is believed that all examined claims pending in this application (after entry of the instant amendment) are in condition for allowance.

Respectfully submitted,

Date: 8 January 2007



Frederick H. Rabin
Reg. No. 24,488

Fish & Richardson P.C.
45 Rockefeller Plaza, Suite 2800
New York, New York 10111
Telephone: (212) 765-5070
Facsimile: (212) 258-2291

30173501.doc

RECEIVED

JAN 14 2004

OFFICE OF PETITIONS